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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Mikumo et al.

Examiner: L. Alexander

Serial No: 10/069,848

Group: Art Unit 1743

Filed: February 28, 2002

Date: December 5, 2005

For: INDICATOR FOR PLASMA  
STERILIZATION

Attorney Docket: 763-30

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
MAIL STOP AF

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

Pursuant to 37 C.F.R. §1.181(a)(1) and M.P.E.P. §§1002.02(c) and 706.07(c), it is respectfully requested finality of the Office Action mailed November 3, 2005 by the Patent and Trademark Office in the above-identified application, be withdrawn as premature, for the following reasons.

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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, **MAIL STOP AF**, Alexandria, VA 22313-1450

Dated: December 5, 2005

*George M. Kaplan*  
George M. Kaplan

A Supplemental Amendment After Final Action was filed with the Request for Continued Examination (RCE) on May 11, 2005. This Amendment

(1) amended previously-pending independent Claim 17, and

(2) introduced a new dependent Claim 40 for the first time.

Both the limitation added to independent Claim 17 (1) *supra* and recitation found in Claim 40 (2) *supra* were presented for examination for the first time during prosecution by this Amendment, with the amendment to independent Claim 17 (1) *supra* being made explicitly in response to the Examiner's comments in paragraph 11 of the Advisory Action previously-mailed April 21, 2005, namely that this particular limitation was not presently recited in the claims. Additionally, this Amendment presented additional claims without canceling a corresponding number of finally-rejected claims, as required by 37 C.F.R. §1.116.

A first final Office Action was mailed July 19, 2005 after filing of the RCE; a Request to Withdraw finality of this particular Office Action was filed, by facsimile, on August 3, 2005. It is pointed out in this Request that (1) a new Claim 40 has been introduced, and (2) the Office Action mailed July 19, 2005 fails to act on Claim 40, on the merits. In a subsequent telephone conference on September 16, 2005, the Examiner in charge of the above-identified application, stated a new Office Action would be issued, due to failure to enter this Request into the file (please see Interview Summary PTOL-413).

The new Office Action mailed November 3, 2005 acts on Claim 40 on the merits, but is still made final. A telephone conference between the Supervisory Examiner and undersigned attorney was unable to resolve the issue of premature finality of the outstanding Office Action. Accordingly, the present Petition is being filed to withdraw finality of the Office Action as premature.

In accordance with M.P.E.P. §706.07(h)VIII., the first Office Action immediately subsequent to filing an RCE may be made final only if the conditions set forth in M.P.E.P. §706.07(b) for making a first action final in a continuation application are met. According to M.P.E.P. §706.07(b), all claims presented for examination must be drawn to the same invention claimed in the earlier application, to make the first Office Action final.

In the present instance, the claims presented in the Supplemental Amendment After Final Action filed with the RCE are not all directed to the same invention as previously-presented. Furthermore, as pointed out *supra*, the total number of claims has been increased by this amendment, without canceling a corresponding number of finally-rejected claims. It is respectfully pointed out Applicants are not challenging the right of the Examiner to reject the pending claims over any combination of prior art. Rather, Applicants are simply pointing out the first Office Action after filing the RCE in the present instance should be nonfinal, to allow Applicants full opportunity to address the rejections raised against the presented claims.

Accordingly, for these reasons, it is respectfully requested finality of the Office Action mailed November 3, 2005 by the Patent and Trademark Office in the above-identified application be withdrawn as premature. A check in the amount of \$130 for the petition fee in accordance with 37 C.F.R. §1.17(f) is enclosed; the right is explicitly reserved to request a refund of this petition fee should the enclosed petition be granted and/or finality of the Office Action be withdrawn.

Early favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "G. M. Kaplan", is written over a horizontal line.

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